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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/621,946 | 07/24/2000 | Venkatachari Dilip | CEI-001US | 5253 |
| 29150 | 7590 | 02/02/2005 | EXAMINER | |
| LEE & HAYES, PLLC 421 W. RIVERSIDE AVE, STE 500 SPOKANE, WA 99201 | | | SUBRAMANIAN, NARAYANSWAMY | |
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3624

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/621,946

Applicant(s)

DILIP ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 52, 53, 56-67 and 71-81 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 52-58 and 72-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-67, 71 and 78-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This is in response to Applicant's communication dated January 10, 2005. The Examiner acknowledges election of claims 59-67, 71 and 78-81 with traverse by the Applicants. Claims 1-10, 52-58 and 72-77 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions. Applicants are respectfully advised to cancel the non-elected claims in response to this office action. Elected claims 59-67, 71 and 78-81 have been examined. The response to Applicant's remarks about restriction/election requirement, rejections and response to arguments are stated below.

Response to Remarks about Restriction/Election requirement

2. The reasons for the restriction/election requirement have been clearly stated in the last office action mailed on December 10, 2004. However the following comments are offered by the examiner in response to remarks made by the applicants and to further clarify the reasons for maintaining the restriction. The restrictions were necessitated by amendments to the original claims and by addition of new claims. The originally claimed invention is very different in scope and method from the inventions claimed by subsequent amendments as evidenced by the vastly different claim steps of the first two inventions. Since the amendments were made after the final, the Examiner would not have been in a position to restrict the invention before the final office action. Similarly the new claims, which are directed to a new invention, were presented after the final and hence they could not have been restricted before the final office action. When an Applicant files an RCE, the parent application is expressly abandoned. Hence an RCE is treated like a new case by the office. The Examiner requested the Applicants to make an election as a matter of courtesy. The Examiner could have prosecuted the claims of group I (drawn to claims

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1-10 and 52-58), as being elected by the Applicants by prior presentation. (See MPEP 819). The Applicants' submission that a search and examination of the three inventions together would not impose a serious burden on the Examiner is not a test of "serious additional burden" imposed on the examiner. The claims in the parent application (Group I) that were examined in the prior office actions are distinct and independent from the amended and new claims of Groups II and III. For these reasons and those discussed in the last office action the restriction of the claims is maintained.

Claim Rejections - 35 USC § 101

3. The claims 59-67 and 78-81 of the invention are rejected under 35 USC § 101 because they are directed to non-statutory subject matter. Claim 59 is drawn to a method comprising a financial management system that is not tied to any technological art. Similarly the dependent claims 60-67 and 78-81 are not tied to any technological art. Claims 59-67 and 78-81 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The term "financial management system" could be interpreted broadly to encompass systems that do not include technology. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are "nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution." *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Board Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 59-67, 71 and 78-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musmanno et al (US Patent 5,940,809) in view of Ray et al (US Patent 6,018,722).

With reference to claim 59, Musmanno discloses a method comprising: a financial management system identifying a first account balance associated with a first account, wherein the first account is associated with a first financial institution (See Musmanno Column 12 lines 4-30 and Applicant's own background disclosure Page 3 lines 1-7); the financial management system determining whether the first account balance exceeds a particular value (See Musmanno Column 1 lines 31-45, before sweeping the funds this determination is done); and if the first account balance exceeds the particular value, the financial management system sweeping funds from the first account to a second account associated with a second financial institution, wherein the first account and the second account have a common account holder (See Musmanno Column 2 lines 10-15, 31-36, 47-52, Column 3 lines 51-61, multiple customer accounts relating to a customer and other institutions imply a second account associated with a second financial institution), and wherein the recommendation to transfer funds identifies an amount to be transferred equal to the value by which the first account balance exceeds the particular value (inherent in the sweeping process disclosed by Musmanno).

Musmanno does not explicitly teach the step of recommending a transfer of funds before sweeping (transferring) the funds.

Ray teaches the step of recommending a transfer of funds before sweeping (transferring) the funds (See Ray Column 2 lines 40-48, 61-63, Column 3 lines 3-25, Column 9 lines 29-43).

Both Ray and Musmanno are concerned with facilitating management of a customer's funds. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the teachings of Ray to the invention of Musmanno. The combination of the disclosures taken as a whole suggests that customers would have benefited from the recommendation before making the transfer. Such transfers are also known in the art as Discretionary Sweep.

With reference to claims 60-67, 71 and 78-81, Musmanno and Ray combined disclose the steps of determining whether the first account balance exceeds a particular value is performed at periodic intervals (See Ray abstract last sentence); determining whether the first account balance exceeds a particular value includes applying at least one rule associated with the first account (one old and well known rule is maintaining minimum balance at the end of the day); wherein the first account is a checking account and the second account is a savings account (See Musmanno Column 1 lines 31-37); wherein the second account pays a higher interest rate than the first account (old and well known, otherwise why do it?); the financial management system determining whether the first account balance is below the particular value; and if the first account value is below the particular value, the financial management system recommending a transfer of funds from the second account to the first account, wherein the recommendation to transfer funds identifies an amount to be transferred equal to the value by

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which the first account value is below the particular value (Inherent feature of the CMA Account disclosed in Musmanno); offering to perform the recommended transfer of funds from the first account to the second account (See disclosure of Ray); executing the transfer of funds from the first account to the second account if the account holder accepts the offer to perform the recommended transfer of funds (See disclosure of Ray); wherein recommending a transfer of funds from the first account to the second account includes automatically transferring funds from the first account to the second account (inherent in the disclosure of Musmanno); one or more computer-readable memories containing a computer program that is executable by a processor to perform the method (inherent in the disclosure of Musmanno); wherein the first account is a checking account and the second account is an investment account (See Musmanno Column 1 lines 31-37); wherein the second account offers a better return than the first account (old and well known, otherwise why do it?); wherein the particular value is a minimum balance associated with the first account (Inherent feature of the CMA Account disclosed in Musmanno and sweep accounts in general); the particular value is a minimum required balance based on historical data (old and well known, the thresholds for sweeping are based analysis of historical data)

Response to Arguments

6. Applicant's arguments with respect to claims 1-10 and 52-70 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a. Dartmouth research and consulting glossaries, Copyright 2000 (See Sweep and Sweep account on page 8. Although the publication is dated 2000, the concepts therein were old and well known much before 2000)

b. Paulson (US Patent 5,893,078) (April 6, 1999) System and Method for Determining Optimal Sweep Threshold Parameters for Demand Deposit Accounts

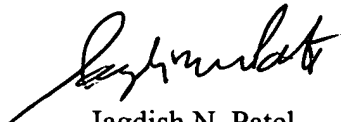
c. Musmanno (US Patent 4,346,442) (August 24, 1982) Securities Brokerage-Cash Management System

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
January 30, 2005



Jagdish N. Patel
Primary Examiner